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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/892,862

06/28/2001

Naoya Hashimoto

Q65135

3124

7590

12/13/2004

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

ADDISON, KAREN B

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,862

Applicant(s)

HASHIMOTO ET AL.

Examiner

Karen B Addison

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8, rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Toshiro (JP 06231939).

APA substantially teaches the claim invention except that it does not show the bobbin outer molding and conducting wires composed of an electrically-insulating material resistant to permeation by sulfur and means for preventing sulfur compounds from permeating the electrically insulating layer and attendant reducing the formation of sulfur compounds on a surface of the conducting wire, thereby suppressing the reduction in adhesive strength of the electrically insulating layer to said conducting wire, wire breakage, and short circuiting between the conducting wires.

Toshiro teaches a solenoid valve comprising (col.1-3) comprising: a electrically insulating layer resistant to permeation made of a material (thermal setting resin, epoxy resin, phenol resin, polyamide resin) coated on the bobbin, outer molding, and conductive coil wires, having means for preventing sulfur compounds from permeating the electrically insulating layer and for preventing sulfur compounds and organosulfur compounds from permeating the electrically-insulating layer and attendant reducing

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the formation of sulfur compounds on the surface of the conducting wire, thereby suppressing the reduction in adhesive strength of the electrically insulating layer to the conducting wire, wire breakage, and short circuiting between the conducting wires by means of thermal setting resin for the purpose of preventing corrosion. Therefore, it would have been obvious to one having ordinary skill in the art at time the invention was made to modify the electromagnetic device of APA with the electrical insulating layer of Toshiro for the purpose of reducing deterioration caused by thermal impact and a PCT test can be reduce.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to select a thermosetting resin as the material of the insulating layer since it has been held to be within the general skill of a worker in the art to select a known material on the basis of suitability for the intended use as a matter of obvious design choice. In re Ileshin, 125 USPQ 416.

Response to Arguments

3. Applicant's arguments filed 9/8/04 have been fully considered but they are not persuasive.

In response to the applicant arguments, that Toshiro does not mention any specific environment, which the coil will be used, and recognition for the need for special protective measure in such and environment is noted.

However, Toshino states that molded coil and bobbin can be used in the automotive parts (col.0001) for the purpose of preventing deterioration.

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In response to the applicants arguments that Toshiro does not teach or suggest that sulfur compounds and organosulfur compounds contained in the oil permeate to the insulating layer is noted.

However, Toshino clearly teaches in (col.0005) the use of sulfur compounds and organosulfur compound (thermosetting resin, epoxy resin and phenol resin) as an insulating layer for the coils and bobbins. The applicant also states these materials on page 10 of his specifications.

In response to the applicant's argument that Toshiro does not teach or suggest that sulfur compounds contained in the oil permeate to the insulating layer coated on a copper wire is noted.

However, the limitations that the applicants rely on (copper wire) are not stated in the claims. It is the claims that define the claim invention, and it is the claims, not the specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Device Inc.* 7 USPQ2d.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen B Addison whose telephone number is 703-306-5855. The examiner can normally be reached on 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on 703-308-1317. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3431.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

KBA
11/28/04


THOMAS M. DOUGHERTY
PRIMARY EXAMINER
GROUP 200